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10/727,143

12/02/2003

David K. Swanson

03-0312 (US01)

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EXAMINER

ROANE, AARON F

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

12/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/727,143 | Applicant(s) SWANSON, DAVID K. | |
| | Examiner AARON ROANE | Art Unit 3769 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-75 is/are pending in the application.
- 4a) Of the above claim(s) 55-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 74 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>07/13/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire et al. (U.S. Patent 6,356,790) in view of Mest (U.S. Patent 6,564,096).

Regarding claims 74 and 75, Maguire et al. disclose a surgical system, comprising: a source of ablation energy (“radio-frequency generator” and alternate/equivalent counterparts in other embodiments, see col. 10:35 – col. 16:14 and figures 13-16); a surgical probe (“catheter” 10, see col. 3:48 – col. 5:43 and figures 1-3) adapted to be operably connected to the source of ablation energy and the source of stimulation energy, the surgical probe including: a single relatively short shaft defining a distal region and a proximal region (the distal portion of catheter body 10, defined from the most proximal end of the most proximal electrode, see col. 3:48 – col. 5:43 and figures 1-3), an ablation element, in the form of ablation/coagulation electrodes (12 and 16, see col. 3:48 – col. 5:43 and figures 1-3) defining an ablation element configuration on the distal region of the same single relatively short shaft, and a stimulation element, in the form of pacing/mapping electrodes (20 and other electrodes interspersed between the ablation electrodes, see col. 3:48 – col. 5:43 and figures 1-3) defining a stimulation element

configuration on the distal region of the same single relatively short shaft, wherein the ablation element comprises a pair of longitudinally spaced ablation elements and the stimulation element is located between the ablation elements, the stimulation element configuration being different than the ablation element configuration. It should be noted that the ablation element and the stimulation element are fixed at respective locations on the same single relatively short shaft such that the location of the ablation element does not change relative to the location of the stimulation element on the same single relatively short shaft (wherein relatively short is equal to or less than 5 feet as broadly interpreted by the examiner). It should be appreciated the ablation/coagulation electrodes and the stimulation electrodes are fixed to the same relatively short shaft and fixed with respect to each other. Although Maguire et al. is silent to a source of stimulation energy, the disclosed invention must contain a source of stimulation energy as it would otherwise be in operable. Lacking an explicit recitation of a source of stimulation energy, it is extremely well known in the art that electrosurgical catheters that have stimulation (i.e. pacing) electrodes are connectable to electrical stimulation energy sources. Mest discloses a cardiac catheter ("catheter" 11, see col. 4:37-54 and figure 1) having a plurality of stimulation electrodes ("ring electrodes" 36, see col. 10:17-49 and figures 1-7) and teach operatively coupling the stimulating ring electrodes to a source of stimulation energy ("pulse signal generator" 1, see col. 10:17-49 and figures 1-7) in order to provide the stimulation electrodes with electrical stimulation energy in order to stimulate biological tissue. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Maguire et al., as

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taught by Mest, to operatively couple the stimulating ring electrodes to a source of stimulation energy in order to provide the stimulation electrodes with electrical stimulation energy in order to stimulate biological tissue.

Response to Arguments

Applicant's arguments with respect to claims 74 and 75 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. It should be noted that Maguire et al. disclose both ablation/coagulation electrodes and stimulation electrodes on a single (and the same) relatively short shaft.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON ROANE whose telephone number is (571)272-4771. The examiner can normally be reached on Monday-Thursday 8:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Roane/
Examiner, Art Unit 3769

/Henry M. Johnson, III/
Supervisory Patent Examiner, Art Unit
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